



# UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE  
United States Patent and Trademark Office  
Address: COMMISSIONER FOR PATENTS  
P.O. Box 1450  
Alexandria, Virginia 22313-1450  
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
-----------------	-------------	----------------------	---------------------	------------------

10/763,027

01/21/2004

Wolfgang Maus

E-80044

9168

24131 7590 12/09/2011  
LERNER GREENBERG STEMER LLP  
P O BOX 2480  
HOLLYWOOD, FL 33022-2480

EXAMINER

MERKLING, MATTHEW J

ART UNIT

PAPER NUMBER

1723

MAIL DATE

DELIVERY MODE

12/09/2011

PAPER

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

RECORD OF ORAL HEARING  
UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS  
AND INTERFERENCES

*Ex Parte* WOLFGANG MAUS

Appeal 2011-001448  
Application 10/763,027  
Technology Center 1700

Oral Hearing Held: November 9, 2011

Before ADRIENE L. HANLON, CHUNG K. PAK,  
LINDA M. GAUDETTE, *Administrative Patent Judges.*

APPEARANCES:

ON BEHALF OF THE APPELLANT:

ALFRED K. DASSLER  
Lerner, Greenberg, Stemmer, LLP  
2445 Hollywood Boulevard  
Hollywood, Florida 33020

1 The above-entitled matter came on for hearing on Wednesday,  
2 November 9, 2011, commencing at 9:03 a.m., at the U.S. Patent and  
3 Trademark Office, 600 Dulany Street, Alexandria, Virginia, before Victor  
4 Lindsay, a Notary Public.

5 P R O C E E D I N G S

6 THE USHER: Good morning. Calendar No. 16, Appeal No. 2011-  
7 001448, Mr. Dassler.

8 JUDGE HANLON: Thank you.

9 THE USHER: Uh-huh.

10 JUDGE HANLON: Good morning, Mr. Dassler.

11 MR. DASSLER: Good morning.

12 JUDGE HANLON: If you have a business card, it would be much  
13 appreciated. Thank you.

14 JUDGE HANLON: You have 20 minutes and you can begin when  
15 you're ready.

16 MR. DASSLER: Twenty minutes?

17 JUDGE HANLON: Yes.

18 MR. DASSLER: Okay. My hearing's a little clogged. I have a cold  
19 and I had some problem with the flight, so I apologize if I have to ask you to  
20 repeat. Okay, I'd like to start by referring to the instant application and the  
21 disclosure therein that the instant application is concerned with eliminating  
22 the barrel-shaped deformation that results from repeated thermal expansion  
23 and contractions that occur for a honeycomb body within a casing. The  
24 Examiner's first rejection is over *Ota*, and here the Examiner merely relies  
25  
26

1 on Figures 1, 2, 3, 5 and 6, and alleges that a contraction limiter is shown by  
2 the reference symbols 5, 9A, 9B, 10, and 11, respectively.

3 But the Examiner has not at all supported this allegation with any  
4 written disclosure within *Ota*. And in fact, the written specification of *Ota*  
5 contradicts the Examiner's allegation that these elements are, in fact,  
6 contraction limiters. Instead, *Ota* explicitly discloses that they are  
7 cushioning members and, to that end, discloses that -- explicitly discloses  
8 that -- the cushion members serve to indirectly join the housing to the case,  
9 the housing case to the honeycomb body, so as not to constrain expansion  
10 and contraction of the honeycomb which is shown in column 4, lines 23  
11 through 29 of *Ota*. Also in column 7, lines 1 through 5 of *Ota*.

12 JUDGE PAK: Counsel, how did you define your contraction limiter  
13 in your specification?

14 MR. DASSLER: In the specification?

15 JUDGE PAK: Yeah. In your specification, how did you limit your  
16 claim indication?

17 MR. DASSLER: Excuse me. I couldn't hear you.

18 JUDGE PAK: How did you define in your specification, relative to  
19 the claim terminology, that contraction limiter?

20 MR. DASSLER: Oh. The contraction limiter is described as several  
21 locations, but mainly that -- let's see -- page 4 is the first example. Line 5,  
22 line 6, "At least one contraction limiter causing an outwardly-directed tensile  
23 stress in at least one part of the matrix so that the average initial diameter of  
24 the matrix decreases by at most 5% during and after the thermal stress."  
25  
26

1 JUDGE PAK: I mean, this description only indicates the function of  
2 the contraction limiter, right?

3 MR. DASSLER: The function?

4 JUDGE PAK: Function. I mean, is there any description of a  
5 structure?

6 MR. DASSLER: There's description with respect to thermal  
7 properties of the material and the surface specific heat and also the -- let's  
8 see -- if you look at the paragraph bridging pages 4 to 5, the contraction  
9 limiter permits expansion and or contraction of the matrix and, accordingly,  
10 does not obstruct these processes as severely as the housing. Let's see.  
11 Right here, line 10 -- or line 11, "The contraction limiter to have a  
12 predeterminable thermal expansion behavior that is displaced in terms of  
13 time or in relation to temperature in comparison with the matrix." I mean,  
14 there are different areas which disclose that it's based on the thermal  
15 properties coefficient of expansion.

16 JUDGE PAK: You claim, as well as you stated in this packet, that the  
17 contraction limiter is configured to provide those functions or properties.

18 MR. DASSLER: Yes.

19 JUDGE PAK: And when you say configure, I presume you are  
20 talking about some sort of configuration, shape of the structure.

21 MR. DASSLER: It's the physical properties. If I go to a chart, it has  
22 a certain tensile strength. It's the material properties that are a physical  
23 characteristic. It has a thermal coefficient of expansion. It has the surface  
24 specific heat. If you look at line 20, "under some circumstances for the  
25 surface specific heat capacity of the contraction limiter to be placed in a  
26

1 region lying between the surface specific heat capacity of the matrix and the  
2 housing. The different thermal expansion and contraction behavior of the  
3 matrix and the housing ensures that the thermal behavior of the matrix is  
4 influenced positively, in particular is slowed down, in the above-described  
5 manner, while at the same time too rigid a casing around the matrix is  
6 avoided.”

7         So its material properties, and those are structural properties of these  
8 contraction limiters, but there’s no -- I mean, it can be done in many  
9 different ways. Just the relationship of these different thermal characteristics  
10 of the material. If you go to any of these materials that are used, any  
11 material, you have different physical coefficients and different strengths.  
12 And that’s what’s disclosed in the specification.

13         JUDGE HANLON: You have some embodiments in Figures 3 and 4,  
14 7A and 7B in Figure 4 it’s a structure.

15         MR. DASSLER: Yeah.

16         JUDGE HANLON: It’s not limited to that particular structure, is  
17 what you’re arguing. So it could actually be a bar disposed between -- it  
18 could be a round ring disposed between the honeycomb core and the case?

19         MR. DASSLER: Yeah. There’s no specific limitation as to the  
20 geometric shape of the contraction limiter. It’s just that it has, you know,  
21 one geometry may work with one material while another geometry may  
22 work with a different material. So it’s a combination of those elements that  
23 results in the contraction limiter as claimed. And to try and claim a specific  
24 combination would be unnecessarily narrow.

25

26

1 JUDGE PAK: Would this be well within the -- for trying to hold any  
2 contraction, for limiting contraction to select, as you said, pick and choose  
3 whatever known material?

4 MR. DASSLER: No. Because --

5 JUDGE PAK: Those properties were known, right? That's what  
6 you --

7 MR. DASSLER: It's anticipation rejection, first of all. And second  
8 of all, Applicants have identified in the specification that they are the ones  
9 that have identified this to be a problem, and that's disclosed in the  
10 specification as well.

11 JUDGE PAK: So the material of the prior uses is the material  
12 different from what you are using. That is, those materials don't have the  
13 same type of properties encompassed by your claims.

14 MR. DASSLER: Correct, because there's no disclosure in the  
15 reference as to the materials. You have a housing, you have a honeycomb  
16 body, and an element in between the contraction limiter, and each one of  
17 these has different thermal characteristics. And not only that, the center of  
18 the honeycomb body heats at a different rate than the outer casing. The  
19 heat's generated different. Those are all things that are taken into  
20 consideration in selecting these parts. And here, in the reference, there's no  
21 mention other than the explicit disclosure that he does not want to constrain -  
22 - *Ota* discloses not to constrain expansion and contraction of the  
23 honeycomb.

24 However, that is specifically what we are doing there. That's what the  
25 Appellants are seeking to do by the matrix. The honeycomb body is  
26

1 connected to the casing, and the casing -- the force exerted on the  
2 honeycomb body is provided from the outer casing via the contraction  
3 limiter. But the disclosure of *Ota* is completely contrary to that, the written  
4 disclosure. The Examiner merely points at figures without any support in  
5 the specification.

6 JUDGE PAK: He didn't identify any material as being correspondent  
7 to the --

8 MR. DASSLER: He tried to. If you look at the, I think it was the  
9 Final Office Action, he had provided a material data sheet for a stainless  
10 steel and made some generalization. If you look on pages 4 and 5 of the  
11 Final Office Action -- actually I think it's also here on the -- it's pages 4 and  
12 5 of the Examiner's Answer. He talks about the stainless steel of *Ota*'s  
13 matrix has a coefficient of thermal expansion of -- and he gives a number  
14 here. And he cites a material web search data sheet. However, this data  
15 sheet pertains to decorative stainless steel for kitchen counters and I think  
16 kitchen elements. And then he bases it upon diameter of a matrix disclosed  
17 in a third reference, *Stroom*.

18 However, it's a linear expansion of these wound -- it's a wound  
19 honeycomb body, so the expansion is going to be based on the length of all  
20 the things that are wound. It's not just on the diameter. He hasn't shown  
21 any calculations here at all. He just puts a number on the end and says --

22 JUDGE PAK: Is your material made of stainless steel?

23 MR. DASSLER: It can be.

24 JUDGE PAK: Couldn't you say its structure can be almost any  
25 structure as long as the material is the same?

26



1 MR. DASSLER: Is the materials the same?

2 JUDGE PAK: Material has the desired thermal properties.

3 MR. DASSLER: Right. So it doesn't have to necessarily be --

4 JUDGE PAK: So if it's the same stainless steel material, there's  
5 reasonable basis for the Examiner to find that they must have the same  
6 contracting properties?

7 MR. DASSLER: Same material as what?

8 JUDGE PAK: Same material that is used as what you call contracting  
9 delimiting material.

10 MR. DASSLER: But which material are you saying is the same?

11 JUDGE PAK: Stainless steel. I just asked you whether the Examiner  
12 is relying on stainless steel material.

13 MR. DASSLER: There's many different grades of stainless steel,  
14 okay, and he chooses one that's suited for decorative applications. And I'm  
15 not saying that that material would necessarily be specific. It's for  
16 decorative structural applications. Type 301, its resistance to atmosphere  
17 and corrosion and its bright, attractive surface make an excellent choice for  
18 decorative structural applications. Applications include automobile molding  
19 and trim, wheel cover, conveyor belts, kitchen equipment, roof draining  
20 systems.

21 I mean, I'm not saying one way or another, but the Examiner has not  
22 shown any calculations. His calculations are based on an assumption that  
23 doesn't even pertain to this number. It's a coefficient of linear expansion.  
24 The diameter, it is linear, but the material that makes the diameter is not  
25 linear in the direction of the diameter. It's a spiral he wound and there's  
26

1 corrugations. And therefore, the Examiner's allegation, furthermore, is  
2 based on the fact that the honeycomb body would never expand and contract  
3 that much, even without a contraction limiter. He relies on this to say that  
4 the honeycomb body itself won't expand and contract that much.

5 But as you see in our specification and in the documentation we  
6 provided in the Reply Brief with the test results showing that yes, you will  
7 achieve this barreling effect due to the expansion and contraction that  
8 occurs.

9 JUDGE HANLON: And that's without the contraction limiter?

10 MR. DASSLER: Correct. And what he's citing there is not material  
11 for the contraction limiter. He's citing material for the honeycomb body and  
12 not at all for the expansion and contraction limiter. So that's why there's no  
13 merit to it. In fact, he kind of abandoned his position on that based on an  
14 interview I had with him. If you look back, there's an interview summary, I  
15 believe, where he says as much. Or at some point, he did indicate that he  
16 kind of, you know, he was not really standing behind these arguments. I  
17 think it's in the Examiner's Answer.

18 Page 10, the Examiner agrees that his arguments are invalid with  
19 respect to the material data based on the thermal expansion. So to continue  
20 on, it's stated that the written disclosure of *Ota*, which is what we really  
21 have to go on, is explicit in that the thermal expansion and contraction of the  
22 honeycomb is not constrained by the case. However, that's exactly how the  
23 contraction limiter of the instant application has claimed, is configured to  
24 operate.

1 JUDGE PAK: The cushion member number 9 Examiner relied on is  
2 made of stainless steel. Am I correct?

3 MR. DASSLER: I don't see that.

4 JUDGE HANLON: *Ota* discloses in column 3, lines 23 to 24, "the  
5 case, the cushion member and the honeycomb are generally made of a  
6 ferritic stainless steel."

7 MR. DASSLER: Okay. Well it says generally, and if you look at the  
8 figures, you also see that he has this spring-shaped configuration to a lot of  
9 his embodiments which would allow this thing to flex, as he discloses. If  
10 you look at Figure 4, Figure 6, Figure 3, his elements, his cushion members,  
11 would flex and not exert those stresses required as in the instant application  
12 is claimed.

13 JUDGE HANLON: Now *Maus*, the Examiner also relied on that  
14 reference.

15 MR. DASSLER: Yes.

16 JUDGE HANLON: That has a similar configuration in Figure 3.

17 MR. DASSLER: Yes. It does.

18 JUDGE HANLON: And the Examiner also made an inherency  
19 rejection based on this reference.

20 MR. DASSLER: Correct. Yes, and here again, if I can continue on  
21 with *Ota*, the Examiner has not met the requirements of inherency for *Ota* --

22 JUDGE HANLON: Okay. I understand that position, but let's just  
23 turn quickly to *Maus*.

24 MR. DASSLER: Okay. Well likewise, in *Maus*, the Examiner here  
25 alleges that this element, the connecting tube 11, is a contraction limiter.

26

1 There's no written disclosure that supports this at all in the reference. Okay?  
2 There's nothing in the *Maus* reference that supports this position. In fact,  
3 Mr. Maus is also the Inventor of the instant application. Beyond that, *Maus*  
4 is concerned with insulating and providing insulating for the honeycomb  
5 body from the casing or outer tube. And in order to improve efficiency at  
6 startup of the catalytic reaction that occurs in his convertor.

7 Here, again, there's nothing in the written disclosure that indicates  
8 that the connecting tube has the physical characteristics to meet the  
9 requirements of the contraction limiter as recited in Claim 1 of the instant  
10 application. So the Examiner has not met the requirements for inherency,  
11 and certainly this element could be placed in there under compression where  
12 a compressed one is placed in there so that there's a -- it's like a spring that's  
13 pre-stressed, and that possibility alone would speak against any inherency.

14 JUDGE HANLON: Well this is the same Inventor, so rather than  
15 making suppositions -- can you tell us how it is?

16 MR. DASSLER: How it is?

17 JUDGE HANLON: Yeah.

18 MR. DASSLER: In the *Maus* reference?

19 JUDGE HANLON: Uh-huh.

20 MR. DASSLER: I mean, no, I don't -- I mean, I can only go by  
21 what's disclosed in the *Maus* reference. And, I mean, that's what's cited  
22 against us. I have not contacted the Inventor with respect to how these  
23 things are in there. And I'm not sure, short of a declaration, how that would  
24 even be, you know, anything I could put forth. And I contacted the  
25 Examiner about the possibility of filing a declaration and he indicated that  
26

1 he wasn't interested in seeing anything of that nature. It wouldn't change  
2 his position.

3 JUDGE PAK: I presume the Applicant would have submitted if in  
4 fact this structure was material to the examination of this case.

5 MR. DASSLER: Excuse me. What's that?

6 JUDGE PAK: I presume Applicant would have submitted the  
7 declaration or information regarding the structure of this material disclosed  
8 in *Maus*, had he been aware that this information was material to the  
9 examination, right?

10 MR. DASSLER: Well I can't speak to that, but I mean, we have to  
11 look at the case as it's in front of us, and the Examiner's relied on inherency  
12 and it's not there. And to take the case out of appeal and file further  
13 declarations or to be required to file an RCE, it didn't seem financially  
14 reasonable to do so after the discussion with the Examiner. I mean, I think  
15 our position is the case on the references alone is what's disclosed in the  
16 reference is sufficient to overcome the reference. Therefore, no declaration  
17 was filed. And also with an anticipation rejection, it's really difficult to say  
18 what would be done with a declaration.

19 JUDGE PAK: What is the 11 made out of?

20 MR. DASSLER: 11?

21 JUDGE PAK: Yeah. That which the Examiner is relying on as the  
22 claimed constraint delimiter.

23 MR. DASSLER: I mean, I'm not sure what it is. I know at one point  
24 it says that it can act somewhat as the casing, so I would imagine it's similar  
25 in respect to what the casing is, too. I mean, I think it just mainly says  
26

1 metallic. But certainly there's no disclosure that there's any difference  
2 between the materials that would result in the contraction limiting as  
3 required in the claims of the instant application. And furthermore, there's  
4 nothing in the reference that says anything about limiting contraction. It's  
5 all about thermal insulation of the honeycomb body from the outer casing in  
6 order to improve the catalytic reaction of the honeycomb body.

7 JUDGE HANLON: Do you have any other questions?

8 MR. DASSLER: Thank you.

9 JUDGE HANLON: Okay. Thank you.

10 (Whereupon, the proceedings, at 9:29 a.m., were concluded.)  
11  
12  
13  
14  
15  
16  
17  
18  
19  
20  
21  
22  
23  
24  
25  
26